

Madrid, April 20th of 2006

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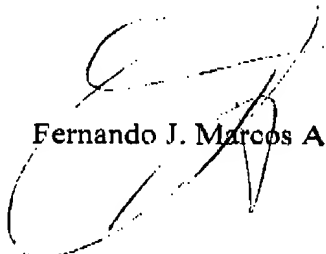
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US Application # 09/857,099

Please, find enclosed my answer to the communication of past 01/25/2006.

IMPORTANT: It would be greatly appreciated an email confirming the correct reception of the present Fax message to the following email address:
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A blank message with the text "7/7 pages received by fax" written in the Subject field, would fit. Thanks in advance.

Best regards,



Fernando J. Marcos Alba

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The author of US Application number 09/857,099 fully agrees with the examiner about a means coincidence between his application and those cited by the examiner (Kishimoto, Tomohiro and Takegawa). Some of these means used by Takegawa, as pointed out by the examiner are the following:

- a programmable frequency divider for selecting a broadcast station
- a station selecting device
- a detector
- a memory

These means are common building-blocks for the radio circuits, especially for PLL synthesized tuners. Since the field for creating new devices is an open field, in my opinion, no matter the new inventions would need to be supported on these elements, provided there is a net difference in the subject-matter claimed by each one. This is surely the case of many valid applications, as any new invention is implemented by some sort of combination of known means.

The applicant knows that the referred technical means used to achieve the technical problem are not hidden for someone skilled in the art, once the problem has been stated in a clear form. For this application the inventive step lies in the approach itself (a device for picking-up a radiophonic audience and enhancing their brand loyalty to a given station, based on a receiver that can only be tuned to a particular station).

First of all, I want to apologize if the arguments that I am going to introduce at once are not fully applicable to US Patents. They have been taken from the European Patent Systems and, of course, it might happen that they were not valid for the American Patent Systems. I suppose that there is a vast common basis for both Patent Systems, in spite of detail differences. I include them here since they were useful for me some years ago, when I took the decision of patenting these ideas.

The Guidelines for Examination in the European Patent Office, Part C, Chapter II, Paragraph 4.9a, require a description in terms of function:

"In order that the requirements of Article 83 and of Rule 27, paragraph 1, subparagraphs (c) and (e) may be fully satisfied it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure."
(Underlined the relevant part)¹.

Consequently, in my opinion, it should not be derived anything from the use of some common building blocks further than they are common state of the art means for

¹ An obvious exception is allowed, when "the functions of the various parts are immediately apparent." This could be the case of the programmable frequency dividers, memories, selectors or detectors.

building up electronic tuners. There is a large gap from the use of these common building blocks in the cited applications (Kishimoto, Tomohiro and Takegawa) and the inventive concept as stated in my application. The subject-matter of US Application number 09/857,099 can better be explained with the help of concepts relating sets. According to claim n° 1, we may call T to the set of predetermined frequencies to which the device can be tuned to, i.e. $T = \{f_1, f_2, \dots, f_n\}$, and also we can call NT to the set of frequencies to which the device cannot be tuned to, i.e. $NT = \{g_1, g_2, \dots, g_m\}$. Then $W = T \cup NT$ represents the whole set of (carrier) frequencies used for broadcasting². A key difference among US Application number 09/857,099 and the known art (including Kishimoto, Tomohiro and Takegawa) is that NT cannot be an empty set (i.e.: $NT \neq \emptyset$) for US Application number 09/857,099, whereas it is always an empty set in the known art.

It might happen that the embodiments proposed in my invention were considered obvious to a person skilled in the art. However, it is also well known that sometimes the inventive step resides more in a clear formulation of a technical problem than in the means used for solving it. The solution may appear obvious, once the technical problem has been clearly stated, as it is accurately established in the aforementioned Guidelines, Part C, Chapter IV, Paragraph 9.43:

"While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that there are various ways in which the skilled person may arrive at an invention. An invention may, for example, be based on the following:

(i) The formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated). Example: the problem of indicating to the driver of a motor vehicle at the night the line of the road ahead by using the light from the vehicle itself. As soon as the problem is clearly stated in this form, the technical solution, viz. the provision of reflective markings along the road surface, appear simple and obvious. For another example see Decision of the Technical Board of Appeal T 2/83, OJ 6/1984, p.265. (...)" (Underlined the relevant part).

I think that it should also be taken into account the Paragraph 9.9 of the said Guidelines, which states a very profound reflection about the truly existence of inventive steps in some cases:

"It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of ex post facto

² For simplicity, this statement is formulated as if only one band and modulation technology would exist.

analysis of this kind. He should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged invention (...)"

In this sense, it is especially useful to review a part of the Description of US Application number 09/857,099 (from page 3, line 24 to page 5, line 2). Below may be found the most relevant part of it, for the reader's convenience:

Anyway, the existing radio receivers always come with a tuning control intended for choosing and changing among different radio stations/chains. They are universal receivers, and from the point of view of broadcasters they **lack selectivity**. Their **addressees** are the radio listeners, and their **function** is to let them tune any radio station/chain. The audience due to them is the natural audience of the radio station/chain, i.e., the audience derived from the listener's satisfaction due to the programs received. Existing radio receivers are unuseful for the objective of enlarging and make the radiophonic audience remain faithful to a given radio station/chain.

Radio receivers intended for commercial broadcasting have been developed under a design philosophy in which the receiver can be tuned to any possible frequency (each frequency corresponding to the reception of a given radio station/chain). This is a deeply rooted philosophy in the radio design technique, so that radio designers haven't considered alternative scenario regarding this question.

This established scenario can be understood as a consequence of the user's interest in receiving the signals of different radio stations/chains with a single device.

But that scenario is not the unique one possible. A more general scenario can be considered where a receiver is conceived for satisfying the needs of third parties that may be other than the user of the receiver.

This generalization appears once a conception prejudice or model prejudice -implicitly assumed by commercial broadcasting radio receiver manufacturers and designers- is overcome. In the established scenario, the receiver has been conceived for the satisfaction of the needs of the receiver's user. As there is a large variety in radio stations/chains, an indefinite communication channel arises between radio stations and users.

But another particular case can be considered inside the generalized scenario, that is dual for the established scenario. In this case the addressee of the device would be a broadcaster. Its needs are different from that of the radio listener, and could be focused in establishing a defined communication channel with the largest possible number of radio listeners.

It is well known that a common source for inventions is the existence of unsatisfied needs: in the case considered, the interest in establishing a definite communication channel between radio stations and radio listeners. The proposed technical solution for this problem consists in a loyalty-generating and pick-up device based on a radio receiver in which the tuning

frequency is fixed and correctly adjusted to a predetermined value. From the point of view of broadcasters, the selectivity of a pretuned loyalty-generating and pick-up device is complete, meaning that, in case the device is used, a unique signal can be obtained: that corresponding to the frequency to which it is pretuned to (so that the device can only receive a given radio station/chain in certain geographic area). In contrast with the universal receiver, the natural addressee for the device is a broadcaster, who should find the way for the device to reach the radio listeners. The function of the device is different to that of the universal receiver, because when used it will tune to a unique frequency. Thus, the device may be a very useful tool for enlarging and make the audience remain faithful to a given radio station/chain.

Now, I will include three more reasons that may not be as formal as the cited Guidelines, but which derive from the market itself.

1. Each year, hundreds of millions of radio receivers intended for commercial broadcasting are manufactured all over the world. There are tens of thousands of different products. They can easily be found anywhere. According to a detailed search that was performed before applying for the patent, none of them can only be tuned to some predetermined frequencies/stations/chains.
2. It is highly remarkable the effort done by the radio stations/chains managers for picking-up more and more listeners, as referred at page 1, lines 11 to 31 of my application. To support this statement, I will show some figures: the largest private broadcaster in Spain spends more than 10% of its gross income in promotion through advertisements. They have got the 41st position in the national largest-advertisers ranking in 1998⁴, ahead of many other much more powerful companies like Toyota (which ranked # 46), Martini (# 47), Rover (# 50), Volvo (# 58), BMW (# 67), McDonalds (# 79), Nokia (# 80), Philip Morris (# 81), BDF Nivea (# 100) or IBM (# 107). Moreover, the said company ranked to the 15th position in the national largest-advertisers over newspapers in 1999⁵. Please, note how the device for which a patent is claimed fulfils a "long-felt need", supporting the inventive step requirement as accurately established in the Guidelines for Examination in the European Patent Office, Part C, Chapter IV, Paragraph 9.9:

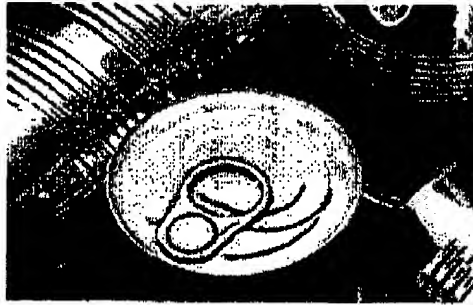
"(...) He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage that is new and surprising, and this

⁴ Source: "Informe Anual de la Comunicación 1999-2000" B. Díaz Nosty. Grupo Zeta. ISBN: 84-930909-3-X, Pg. 363.

⁵ Source: "Noticias de la Comunicación". Nº 197, Noviembre de 2000. ISSN: 1130-8842. Pg. 142.

can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step. The same applies when the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need. (...)" (Underlined the relevant part).

3. In my opinion, there are many new ideas that may have a simple appearance at a first glance, but which can generate a tremendous impact over their markets. I am referring to ideas (and their associated inventive steps) which open new segments or categories into their markets. Of course, not all of these ideas are patentable; in addition the commercial success may be a very good meter for finding the true existence of an inventive steps. Unfortunately, commercial success, if it really ever happens, uses to require much more time than that allowed for the evaluation of a patent application. I have been thinking about an example to illustrate what I want to say, and I have found this one: The common metallic can (or tin) for packing food inside. I have found in Internet that it was developed by Nicolas Appert and Peter Durand in 1810, for the army of Napoleon. The can and the tinplate were part of the state of the art at those days. Mr. Appert discovered how to pack the food in a container made of tinplate in such a way that the food would keep preserved for years. Many innovations have taken place for the can since 1810. Surely some of these innovations were brilliant, and probably many of them received a patent. But for many years the can has been a container that had to be opened with a special tool (the can opener) and it required a lot of physical force and some skill to be performed. Then somebody, after having thought "Why things have to be so difficult?" discovered the easy-opened cans. Apparently, just two very common mechanical elements have to be added to a regular can for converting it into an easy-opened can: a slot or precut (around the cap's perimeter) and a ring to be pulled. Both elements were obvious at the time of the invention for a person having ordinary skill in the art of canning. It is even possible to imagine that the claims of the regular can's patent did not limit their scope as much as to exclude the possibility of implementing on it the perimetral slot nor the ring for pulling (common mechanical building blocks). However, it is obvious that the easy-opened can is a huge invention (if not from a legal point of view, at least it is so for the common people). I think this is a good example of how the obviousness may be so ... once the problem is clearly stated.



The applicant kindly requests the examiner to consider again the novelty of its application, taking into account these explanations.

Best regards,

Fernando J. Marcos Alba

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